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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,386	05/22/2000	William T. Carden JR.	35672-163980	1657

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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/01/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,386

Applicant(s)

CARDEN, WILLIAM T.

Examiner

Nathan Hillery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-68 is/are rejected.
- 7) ☒ Claim(s) 22, 25, 34-36, 38, 41, 50-52, 54, 57 and 66-68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/9/04; 7/29/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 7/29/04.
2. Claims 21 – 68 are pending in the case. Claims 21, 37, and 53 are independent.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21 – 36; 37 – 52; and 53 – 68 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25 – 36, 39 – 42; 43 – 54, 57 – 60; and 61 – 72, 75 – 78 respectively of copending Application No. 09/576,386. The conflicting claims are identical except that the instant application discloses publishing a manuscript and the co-pending application discloses publishing a submission; therefore, the applications are not patentably distinct from one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

5. Claims 22, 25, 34 – 36, 38, 41, 50 – 52, 54, 57, and 66 – 68 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 21, 37, and 53 are Markush claims; therefore, it is only necessary to follow one path as set forth in those claims. The path(s) limited by the aforementioned dependent claims may or may not be followed; thus, the aforementioned dependent claims do not fully further limit the parent claim(s) from which they depend. Consequently, no further action on the merits with respect to the dependent claim(s) either in part as a whole will be taken by the Office at this time.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21 – 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. **Regarding independent claims 21, 37, and 53**, the metes and bounds of the claims cannot be determined because of the various alternatives presented (use of or-clauses) in the claims. Due to the Markush nature of many of the limitations, the claims are unclear; in addition, some limitations lack antecedent basis depending on what path is taken. For example, the limitation at line 19, "determining whether to include in *said*

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one or more meetings or journals...” is not well defined unless the path in line 9 is followed, “...a staff person managing *one or more meetings or journals...*” Thus, depending on what particular path(s) is/are followed certain limitations and/or depending claims will not be considered further on the merits either as a whole or in part. See the section claim objections above for further clarity regarding treatment of the dependent claims.

9. **Regarding dependent claim 31, 47, and 63**, the metes and bounds of “secure” are unclear. Consequently, the claim will be interpreted, as a broad example of claims 30, 46, and 62, respectively, and thus would be incorporate substantially similar subject matter as claims 30, 46, and 62.

10. **Regarding the dependent claims w/in claims 21 – 68**, the claims are rejected for fully incorporating the deficiencies of the base claim(s) from which they depend.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 21, 26 – 33, 37, 42 – 49, 53, and 58 – 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ivanov (previously cited) and further in view of Leone et al. (cited by Applicant).

13. **Regarding independent claim 21**, Ivanov teaches that *in order to build a particular workflow application, a designer provides facilities to create, store, access,*

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modify, delete documents and reviews, typically using a database management system. Each logical document and/or review can be implemented using a plurality of physical records. In the current embodiment, a document/review is implemented as a single Lotus Notes document, and all document related operations are provided by the Lotus Notes environment (2) defines the data components in the structure of each document and review. Document 44 stores data components for each role 48 and stage 50 relevant for its particular contents (Column 16, lines 20 – 31), which provide for

receiving a manuscript at a computer system, wherein said computer system includes at least one database to store a plurality of submissions, and wherein said plurality of submissions includes at least one of a manuscript, correspondence, a review, descriptive information, or approval for publication of said manuscript; and storing said manuscript in said computer system, wherein said manuscript is accessible to a plurality of clients, wherein said plurality of clients includes an author of said submissions, a reviewer, an editor, or a staff person managing one or more publications; that

modifications in the review authorizations between the moment the document is submitted and the moment reviews are requested can be reflected in the review process; in this respect, the reviewer list can be computed using the programming language just before notifications are sent out (Column 6, lines 14 – 19), which provide for

receiving a selection of at least one reviewer for said manuscript from a list of reviewers, wherein said list of reviewers is maintained by said computer system and providing access to said manuscript to said at least one reviewer; and that if at any time when it is a

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reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one (Column 27, lines 15 – 22), which provide for receiving one or more reviews including at least one of a revised manuscript, correspondence, comments, recommendations, a score, relevant information or a decision, wherein said decision is about at least one of accepting, rejecting, or requesting revisions to said manuscript. Ivanov does not explicitly teach translating... However, Leone et al. teach that *the preferred embodiment of the invention is illustrated with regard to a special agent process that converts IBM's non-HTML formatted books created by the IBM BookManager Build process into HTML formatted ones. The special agent process will be called "DITA" herein. DITA is the core component process that produces the HTML formatted topics (both text and link anchors) generated by hypertext links. This provides real-time conversion of the non-HTML format to HTML (Column 5, lines 51 – 59), which provide for translating one or more of said manuscript into a common format of said computer system.* It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Ivanov with that of Leone et al. because such a combination would allow the users of Ivanov the benefit of *an improved method and means for automatically converting non-HTML text and hypertext links to HTML texts and HTML links in electronically formatted documents for access over communications networks (Column 1, lines 54 – 58).*

14. **Regarding dependent claims 26, 28 and 29**, Ivanov teaches that *in the second solution, some reviewers do not have the authority to reject a proposal but they can argue why the proposal should be approved or rejected. Their comments are passed to higher ranking reviewers who can approve or reject a proposal; earlier reviewers also can dynamically modify the workflow by engaging the higher ranking reviewers who otherwise would not be involved in the review process* (Column 26, lines 36 – 43), which provide for **said list of reviewers is provided to said computer system by one or more of said plurality of clients, that one or more of said plurality of clients produces said list of reviewers, and that said list of reviewers is based on qualifying criteria, wherein said qualifying criteria includes at least one of (i) a reviewer's area of specialty, (ii) a reviewer's prior review history, or (iii) a reviewer's professional associations.**

15. **Regarding dependent claims 27**, Ivanov teaches that *the reviewer list can be computed using the programming language just before notifications are sent out* (Column 6, lines 17 – 19), which provide that **said computer system produces said list of reviewers.**

16. **Regarding dependent claims 30 and 31**, Ivanov teaches that *some of the features of a workflow application built according to the present invention are: (a) provides different access (security) levels based on user's electronic identity, to protect sensitive information from unauthorized users ...* (Column 5, lines 14 – 18), which provide that **said computer system requires authentication of identity from one or**

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more of said plurality of clients, and that said access provided by said computer system is secure.

17. **Regarding dependent claim 32**, Ivanov teaches that *if at any time when it is a reviewer's turn to evaluate a proposal he/she composes a rejection, then the proposal itself is rejected. The preparer can choose to modify the proposal and resubmit it as a revision. The new proposal will go through the same approval process like the original one* (Column 27, lines 15 – 22), which provide for **receiving a revision to said manuscript, wherein the author of said manuscript provided said revision based on said reviews; and providing said revision to said at least one reviewer for additional review.**

18. **Regarding dependent claim 33**, Ivanov teaches that *FIG. 1 is a high level representation of a networked computer system 20, in particular, a Lotus Notes system. Such system connects a number of personal computers 22 and a number of server computers 24, allowing them to communicate. A user seated in front of personal computer 22 can create, access, modify, and delete data which is shared with other users and resides on server computer 24. Each user has an electronic identity and can communicate with other users via an electronic mail system* (Column 7, lines 23 – 31), which provide that **said plurality of clients access said computer system via at least one of the Internet, an internet, or an intranet.**

19. **Regarding independent claim 37**, the claim incorporates substantially similar subject matter as claim 21, and is rejected along the same rationale.

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20. **Regarding dependent claim 42**, the claim incorporates substantially similar subject matter as claim 26, and is rejected along the same rationale.

21. **Regarding dependent claim 43**, the claim incorporates substantially similar subject matter as claim 27, and is rejected along the same rationale.

22. **Regarding dependent claim 44**, the claim incorporates substantially similar subject matter as claim 28, and is rejected along the same rationale.

23. **Regarding dependent claim 45**, the claim incorporates substantially similar subject matter as claim 29, and is rejected along the same rationale.

24. **Regarding dependent claim 46**, the claim incorporates substantially similar subject matter as claim 30, and is rejected along the same rationale.

25. **Regarding dependent claim 47**, the claim incorporates substantially similar subject matter as claim 31, and is rejected along the same rationale.

26. **Regarding dependent claim 48**, the claim incorporates substantially similar subject matter as claim 32, and is rejected along the same rationale.

27. **Regarding dependent claim 49**, the claim incorporates substantially similar subject matter as claim 33, and is rejected along the same rationale.

28. **Regarding independent claim 53**, the claim incorporates substantially similar subject matter as claim 21, and is rejected along the same rationale.

29. **Regarding dependent claim 58**, the claim incorporates substantially similar subject matter as claim 26, and is rejected along the same rationale.

30. **Regarding dependent claim 59**, the claim incorporates substantially similar subject matter as claim 27, and is rejected along the same rationale.

31. **Regarding dependent claim 60**, the claim incorporates substantially similar subject matter as claim 28, and is rejected along the same rationale.

32. **Regarding dependent claim 61**, the claim incorporates substantially similar subject matter as claim 29, and is rejected along the same rationale.

33. **Regarding dependent claim 62**, the claim incorporates substantially similar subject matter as claim 30, and is rejected along the same rationale.

34. **Regarding dependent claim 63**, the claim incorporates substantially similar subject matter as claim 31, and is rejected along the same rationale.

35. **Regarding dependent claim 64**, the claim incorporates substantially similar subject matter as claim 32, and is rejected along the same rationale.

36. **Regarding dependent claim 65**, the claim incorporates substantially similar subject matter as claim 33, and is rejected along the same rationale.

37. Claims 23, 24, 395, 40, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ivanov (previously cited) and Leone et al. (cited by Applicant) as applied to claims 25, 30 – 36, 39, 43, 48 – 54, 57, 61, 66 – 72, and 75 above, and further in view of Plantz et al. (as cited by Applicant).

38. **Regarding dependent claims 23 and 24**, neither Ivanov nor Plantz et al. explicitly teach **upload** or **browser**. However, Plantz et al. do teach that *an HTML-based word-processing system that allows instant downloading of text to existing pre-press formats, such as Quark or Pagemaker, and uploading of pictures, graphics, video or audio data in any format* (Column 5, lines 36 – 40), which provide for **receiving said**

manuscript includes at least one of (i) receiving a file uploaded to said computer system or (ii) receiving data pertaining to said manuscript provided to said computer system from a browser interface, and that said manuscript includes data in the form of text, images, graphics, or multimedia. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions of Ivanov and Leone et al. with that of Plantz et al. because such a combination would allow the users of Ivanov and Leone et al. the benefit of *a method to allow essentially simultaneous viewing of an entire in-process document, which easily can be downloaded for publication in a variety of formats, including but not limited to CD-ROM, hard-copy book, or on-line HTML format* (Column 5, lines 18 – 23).

39. **Regarding dependent claim 39**, the claim incorporates substantially similar subject matter as claim 23, and is rejected along the same rationale.

40. **Regarding dependent claim 40**, the claim incorporates substantially similar subject matter as claim 24, and is rejected along the same rationale.

41. **Regarding dependent claim 55**, the claim incorporates substantially similar subject matter as claim 23, and is rejected along the same rationale.

42. **Regarding dependent claim 56**, the claim incorporates substantially similar subject matter as claim 24, and is rejected along the same rationale.

Response to Arguments

43. Applicant's arguments with respect to claims 1 – 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

44. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 6:30 a.m. - 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER